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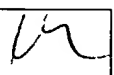
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,351	06/27/2001	Jerome A. Legerton	6734-6	7508
21324	7590	04/21/2004	EXAMINER	
HAHN LOESER & PARKS, LLP TWIN OAKS ESTATE 1225 W. MARKET STREET AKRON, OH 44313			RAIZEN, DEBORAH A	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n No. 09/894,351	Applicant(s) LEGERTON ET AL. 	
	Examiner Deborah A. Raizen	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 45-51 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-28 and 45-51 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 27 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☒ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0403</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The indicated allowability of claims 7, 8, 13, 14, 17, 18, 23, 26, and 28 is withdrawn in view of the reconsideration of applicant's priority document 60/214554. Rejections based on the reconsideration follow.

Priority

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application 60/214554 upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-28 and 45-51 of this application. The limitation "sigmoidal", found in claims 1-24 and 45-51 or in the respective base claims, is not disclosed in the provisional application, but rather, the term "S" curve is used. The limitation "conoid", in claims 25-28 or the respective base claims, is not disclosed, but rather, the term "cone" is used.

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in China on 20 October 2000 (application number 00129863.1). It is noted, however, that applicant has not filed a certified copy of the Chinese application as required by 35 U.S.C. 119(b).

Drawings

4. New corrected drawings (for all the drawings) are required in this application because the drawings have many informalities. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer

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prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-28 and 45-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. In regard to claims 1-24 and 45-51 the limitation “sigmoidal” is not disclosed in the provisional application to which applicants claim priority, but rather, the term “S” curve is used.

8. In regard to claims 25-28 the limitation “conoid” is not disclosed, but rather, the term “cone” is used.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over El Hage (5,695,509, cited in applicants' IDS, paper #4) in view of Harris (5,270,051, cited in applicants' IDS, paper no. 6, of April 11, 2003). El Hage discloses a corneal contact lens (Fig. 5B) comprising a central zone (10) having a posterior surface curvature (Fig. 5B), wherein the curvature of the central zone is designed to correct astigmatism by reshaping the cornea(col. 2, line 46-52), a connecting zone (the zone with peaks labeled 12 and 14, also labeled the relief and anchor zones) having a posterior surface (Fig. 5B) and provided adjacent and concentric to said central zone (Figs. 5A and 5B), said connecting zone having a shape defined as a sigmoidal curve (Fig. 5B), and at least one peripheral zone (16) having a posterior surface (Fig. 5B) and provided adjacent and concentric to said connecting zone (Figs. 5A and 5B). However, El Hage does not describe the curvature of the central zone as toric. Harris discloses a corneal contact lens in which the curvature of the central zone is toric (col. 11, lines 53-60 and Fig. 4C). Furthermore, Harris teaches that the toric curvature is desirable for correcting astigmatism by reshaping the cornea (col. 11, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art to make the curvature of the central zone of the El Hage corneal contact lens toric, as disclosed by Harris, because such toric curvature is desirable for correcting astigmatism by reshaping the cornea.

Response to Arguments

11. Applicant's arguments filed on December 29, 2003, have been fully considered but they are not persuasive.

Applicants assert that a toric surface is not consistent with the formation of the lens as described by El Hage because El Hage teaches forming the entire surface from a “best fit” curve as stated in col. 10, lines 28 and following. However, as El Hage explains in col. 8, line 55 to col. 10, line 50, the parameters of each of the zones are chosen separately. The polynomial curve that is fitted to these parameters allows the zones to match one another at their peripheries. Furthermore, because the calculation is performed along up to 360 semi-meridians spaced 1 degree apart, a toric surface for the central zone can straightforwardly designed by modification of the equation in col. 9.

Applicants assert that El Hage teaches away from the subject matter of claim 3 because the parameters of the separate zones are used to determine the shape of the disclosed polynomial equation. However, the polynomial equation does not prevent the central zone from being toric, but rather, can be used to model a toric shape by appropriate choice of parameter.

Applicants assert that there is no motivation to combine the teachings of El Hage and Harris other than based upon the teachings of the present application. However, as explained above, El Hage discloses a contact lens designed to correct astigmatism by reshaping the cornea, wherein the central zone has a shape that is chosen to correct astigmatism. Harris discloses that a toric curvature for the central zone is appropriate for a contact lens that corrects astigmatism by reshaping the cornea. This disclosure provides sufficient motivation to combine the teachings of Harris with those of El Hage.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A. Raizen whose telephone number is (571) 272-2336. The examiner can normally be reached on Monday-Friday, from 10:00 a.m. to 3:00 p.m. Eastern Standard Time (a part-time schedule).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 (please note that this number is different from the previous two numbers provided until the summer of 2003).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. External customers should be directed to EBC representatives, who can be reached at **703-305-3028 or toll free at 866-217-9197** between the hours of **6 a.m. and midnight Monday through Friday EST**, or by e-mail at: **ebc@uspto.gov**. Additional information is available on the Patent EBC Web site at: **<http://www.uspto.gov/ebc/index.html>**.

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A handwritten signature in black ink, appearing to read "Scott J. Sugarman". The signature is stylized with a large, looping "S" and a long, sweeping underline.

Scott J. Sugarman
Primary Examiner